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Filing date: **01/11/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86301489
Applicant	Infor (US), Inc.
Applied for Mark	INFOR FACTORY TRACK
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Submission	Applicants Request for Remand and Amendment
Attachments	INFOR FACTORY TRACK - Request for Remand - 1-11-16.pdf(168767 bytes)
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Date	01/11/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APPLICANT: Infor (US), Inc.

SERIAL NO.: 86/301,489

MARK: INFOR FACTORY TRACK

FILING DATE: June 5, 2014

INT'L CLASSES: 09 and 42

To: Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandra, Virginia 22313-1451

Attn.: Trademark Trial and Appeal Board

REQUEST FOR REMAND TO AMEND APPLICATION

In an action dated November 10, 2015, the Examining Attorney denied Applicant's Request for Reconsideration of the above-referenced mark, INFOR FACTORY TRACK, maintaining her refusal to register the mark absent disclaimer of "FACTORY TRACK" on the basis that such wording is allegedly merely descriptive of the identified goods and services. Applicant now desires to amend its application to enter a disclaimer of the term "FACTORY" in order to obviate the basis for the Examining Attorney's refusal. Accordingly, pursuant to Sections 1205.01 and 1209.04 of the Trademark Trial and Appeal Board Manual of Procedure, Applicant hereby requests that the Board suspend the Appeal and remand the application to the Examining Attorney for consideration of the following amendment.

I. DISCLAIMER OF "FACTORY"

In response to the Examining Attorney's requirement that Applicant disclaim the term "FACTORY," Applicant hereby requests that the following disclaimer be included in the Application:

No claim is made to the exclusive right to use "FACTORY" apart from the mark as shown.

In light of the foregoing, Applicant respectfully submits that all publication requirements for the subject mark INFOR FACTORY TRACK (with "FACTORY" disclaimed) have been satisfied, without disclaimer of "TRACK." Indeed, the word "TRACK," as used in Applicant's mark, is at worst suggestive, not merely descriptive, as it by no means *immediately* describes a feature or characteristic of the applied-for goods and services. Applicant's unique arrangement of the components of its mark, terminating in "TRACK," transforms the verb "TRACK" into a noun, thus creating a novel and distinctive commercial impression. See generally Henry Hitchens, Those Irritating Verbs-as-Nouns, N.Y. Times, March 30, 2013, *available at* <http://opinionator.blogs.nytimes.com/2013/03/30/those-irritating-verbs-as-nouns/? r=0> (describing the transmutation undergone when verbs are used as nouns and the transformative impact such conversion has on readers), attached to Applicant's Request for Reconsideration. Indeed, in contrast to the term "tracking," which may immediately be understood as descriptive

of the goods and services, Applicant's creative, novel, and unexpected use of the verb-turned-noun "TRACK" necessarily requires consumers to engage in at least a minimal degree of thought, imagination, and mental pause in order to associate the "TRACK" portion of the mark with Applicant's goods and services.

Applicant's position against descriptiveness of "TRACK" is further underscored by the numerous third-party registrations previously made of record by Applicant that contain the term "TRACK" for highly similar goods and services on the Principal Register without disclaimer of "TRACK" (or claim of acquired distinctiveness), including:

MARK	REGISTRATION NO.	RELEVANT GOODS/SERVICES
SUNSHINE TRACK ["SUNSHINE" disclaimed]	4614362	computer software for providing financial information to healthcare providers [Cl. 09]
INSIGHT TRACK	4487703	computer software for the restaurant industry that allows the user to that allows the user to track service metrics; computer software for use in a customer management systems that allows the user to track service metrics; computer software for monitoring a business's speed-of-service, specifically, allowing a user to track service metrics [Cl. 09]
BIO TRACK and Design	4360921	access control and alarm monitoring systems; biometric fingerprint door lock; biometric identification apparatus; computer programs for the enabling of access or entrance control; electronically operated high security lock cylinders; entry/exit security portal comprised of an electronic passageway equipped with biometric devices for identification verification and detection of impermissible items being carried through; facilities management software, namely, software to control building environment, access and security systems; security

MARK	REGISTRATION NO.	RELEVANT GOODS/SERVICES
		products, namely, entry door systems comprising touch pads and security doors [Cl. 09]
FAST TRACK	4401523	application service provider (asp) featuring software for medical affair management and information exchange; providing a website featuring non-downloadable software for medical affair management and information exchange; providing an on-line computer database featuring medical and scientific research information in the field of cancer and immunological disorders that allows for the input and collection of scientific and research data and information; none of the foregoing software for providing operational efficiencies for the monitoring within hospitals of patient placement, patient transport, procedure status, and management of hospital professionals and staff [Cl. 42]
SAMPLE TRACK ["SAMPLE" disclaimed]	4121323	computer software for electronic data management in the field of materials testing [Cl. 09]
VIEWPOINT V6 FAST TRACK	4145067	cloud computing featuring software for the construction industry for use in back office operations, payroll, accounts payable, accounts receivable, job costing, general ledger, cash management, job billing, subcontract ledgers, purchase orders, equipment management, inventory, material sales, human resources, project management, communications monitoring and management, and user database management [Cl. 42]
ADVANTAGE TRACK	4010551	monitoring the status of and identifying potential problems with the shipment of packages and freight; providing a website featuring non-downloadable software that facilitates monitoring the status of and identifying potential problems with the shipment of packages and freight [Cl. 42]
K TRACK	4065478	software used in ophthalmology for the visualization of corneal curvature [Cl. 09]
COMMISSIONTRACK ["COMMISSION" disclaimed]	2997161	computer software for processing data information pertaining to sale orders and invoices for vendors and salespersons [Cl. 09]

MARK	REGISTRATION NO.	RELEVANT GOODS/SERVICES
SMART TRACK	2639646	integrated processing system comprised of computer hardware and software used to manage and display product, inventory, parcel or document location information and status [Cl. 09]
TOUCH DATA TRACK ["DATA" disclaimed]	3770994	computer software for use by security guards for documenting specific physical locations visited during their rounds and for producing reports and analysis of this data [Cl. 09]
TRAIN TRACK	4355809	computer software for tracking trainings, classes, electronic exams, or certifications required and completed by employees, students, or groups of individuals; downloadable computer software for tracking trainings, classes, electronic exams, or certifications required and completed by employees, students, or groups of individuals; downloadable software for tracking trainings, classes, electronic exams, or certifications required and completed by employees, students, or groups of individuals [Cl 09]
JOB TRACK ["JOB" disclaimed]	3621896	computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information relating to job safety analysis and risk management [Cl. 09]
FAST TRACK 2+2	2359855	vehicle drive-thru timers for measuring, collecting, analyzing and displaying data relative to drive-thru service and computer software for use in operating vehicle drive-thru timers [Cl. 09]
PALLET TRACK ["PALLET" disclaimed]	2208571	computer software for use in managing production, inventory, payroll, repairs, employee performance and wages, and database management in the field of shipping pallets [Cl. 09]
MONEY TRACK	1976681	computer software for cargo revenue accounting [Cl. 09]
MARINE TRACK ["MARINE" disclaimed]	1790218	computer software for use in customer follow-up by retail boat dealers [Cl. 09]
DIGI .TRACK	4612623	computer software and hardware for geosynchronous positioning, locating, dispatching and following the progress of vehicles, vehicle logistics and

MARK	REGISTRATION NO.	RELEVANT GOODS/SERVICES
		administrative issues relating to local and over-the-road trucks, namely, administrative issues relating to communicating information about the vehicle's condition and actions occurring on or about the vehicle, and to electronic communication between the vehicle operator and a dispatching location; not for use in hospitals or healthcare facilities [Cl. 09]
ACA-TRACK	4831401	computer software for use in human resources management and for statutory and regulatory compliance and report generation in the field of health insurance [Cl. 09]; providing temporary use of on-line non-downloadable software for use in human resources management, and for statutory and regulatory compliance and report generation in the field of health insurance [Cl. 42]
ACA-TRACK and Design	4831405	computer software for use in human resources management and for statutory and regulatory compliance and report generation in the field of health insurance [Cl. 09]; providing temporary use of on-line non-downloadable software for use in human resources management, and for statutory and regulatory compliance and report generation in the field of health insurance [Cl. 42]

Given that the Trademark Office has permitted registration of these "TRACK"-formative marks on the Principal Register without disclaimer of "TRACK" (or a claim of acquired distinctiveness), Applicant's mark INFOR FACTORY TRACK is at least as deserving, if not more so, of registration without disclaimer of "TRACK."

In her action dated November 10, 2015, addressing her third-party registrations of record, the Examining Attorney contends that such registrations "show that there is clear evidence on the register of the descriptive treatment of . . .

'track' with regard to similar goods and services to applicant in this case." Applicant respectfully submits that this assertion is flawed for at least two reasons. First, the fact that the number of relevant third-party registrations made of record by Applicant outnumber those of the Examining Attorney directly undermines this alleged "clear evidence." Second, the fact that the registrations proffered by the Examining Attorney are registered on the Supplemental Register alone does not suggest "descriptive treatment" of "TRACK" by the P.T.O. See, e.g., In re Serv-A-Portion Inc., 1 U.S.P.Q.2d 1915, 1915-16 (T.T.A.B. 1986) (explaining that Supplemental Registrations do not "reflect an office policy as to the nonregistrability of such marks on the Principal Register").

In view of the foregoing, because the term "TRACK" as used in Applicant's mark INFOR FACTORY TRACK is not merely descriptive, and to ensure consistent treatment between Applicant's mark and the above-mentioned registrations, Applicant respectfully requests that the Examining Attorney enter the disclaimer of "FACTORY" into the record, withdraw her requirement to disclaim "TRACK," and approve Applicant's mark INFOR FACTORY TRACK for publication without disclaimer of "TRACK."

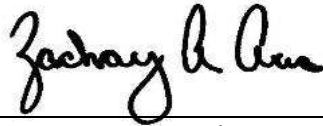
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II. CONCLUSION

As the concerns of the Examining Attorney and the Trademark Trial and Appeal Board have been satisfied, Applicant respectfully requests that its mark be passed on to publication.

Respectfully submitted,

INFOR (US), INC.



Dated: January 11, 2016


By:

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is addressed to the Trademark Trial and Appeal Board, Hon. Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, and is being deposited via the Electronic System for Trademark Trials and Appeals (ESTTA) on January 11, 2016.



Bradford C. Craig